

REMARKS/ARGUMENTS

Claims 1 through 20 are presently pending. In an office action mailed November 19, 2003 (Paper No. 7), claims 1-5 were rejected under 35 U.S.C. 103(a) as being anticipated by U.S. Patent 6,195,006 granted to Bowers et al. (hereinafter *Bowers I*) in view of U.S. Patent 5,732,401 granted to Conway (hereinafter *Conway*). These rejections are respectfully traversed.

It is further noted that a protest under 37 C.F.R. 1.291(a) has been filed on January 7, 2004, alleging that claims 1-5 should be rejected under 35 U.S.C. 103(a) as being anticipated by U.S. Patent 5,963,134 granted to Bowers et al. (hereinafter *Bowers II*) in view of WO 01/88884, (hereinafter *McWilliams*). It is noted that *Bowers I* is a continuation of *Bowers II*, and thus 10 contains the same subject matter as *Bowers II*. It is further noted that *Bowers I* was provided by the Applicant in an Information Disclosure Statement filed on November 5, 2003. While the Applicant believes that the art cited by the Examiner is more pertinent than the art cited by the Protestor, the allegation in the protest shall also be addressed, even though it has not been adopted by the Examiner, is not a basis for the rejection of the claims, and the Applicant has not 15 been requested to comment on the protest by the Examiner.

Bowers I in view of *Conway* fails to provide a prima facie basis for the rejection of claims 1-5 under 35 U.S.C. 103(a), as they fail to disclose each element of the claimed invention. For example, claim 1 includes a "method of equipment management and identifying assets for a sports team comprising the steps of: a. receiving equipment; b. affixing 20 a barcode to said equipment; c. identifying said equipment by scanning said barcode with a scanning device; d. classifying said equipment by equipment group; e. turning a group flag on for a potential asset group; f. issuing said equipment; g. assigning said equipment to an individual profile; h. turning an individual flag on for an asset-creating individual profile; i. recording the return of said equipment after an asset-creating event; j. recording the usage, 25 in said asset-creating event, of said equipment; k. turning an event flag on for equipment used in said asset-creating event; l. determining if said equipment is now an asset by checking for a group flag, an individual flag and an event flag; m. deactivating said asset." (Emphasis added). In contrast, it is admitted by the Examiner that *Bowers I* fails to disclose turning on a flag for an item after the occurrence of a certain event and checking to see if the flag has been

turned on, but it is asserted that the associated missing elements in *Bowers I* are disclosed in *Conway*, which discloses "a flag 97 indicating whether the supply has been "costed," i.e., charged to a patient and *assumed to be consumed in supplying services to that patient*" (emphasis added). However, *Conway* fails to disclose an "asset creating individual profile" or 5 an "asset creating event," and instead, only discloses asset destroying events - events in which the supply has been charged to a patient and is assumed to be consumed. All patients are asset consuming individuals, and there is no such thing as an "asset creating individual profile" disclosed in *Conway*. Likewise, all events are asset destroying, such that there is no recording of the return of equipment after any event, much less an asset-creating event, no 10 recording of the usage in the non-existent asset-creating event of said equipment, and no turning on of an event flag for equipment used in the non-existent asset-creating event. Thus, 15 *Bowers I* in view of *Conway* fails to disclose each element of the invention of claim 1.

Likewise, claim 2 includes "turning the flag off for equipment assigned to a non-asset creating individual profile; i. recording the return of said equipment after an asset-creating event; j. recording the usage of said equipment in said asset-creating event; k. determining if 20 said equipment is now an asset by checking for an asset flag turned on and use in an asset-creating event." Again, *Conway* fails to disclose the concepts of non-asset creating individual profiles, turning an asset flag off if equipment is assigned to a non-asset creating individual, usage of equipment in an asset creating event, and checking to see if an asset flag is turned on for the piece of equipment and whether the equipment has been used in an asset creating event. Thus, *Bowers I* in view of *Conway* fails to disclose each element of the invention of claim 2.

Claim 3 includes "classifying equipment into equipment groups and individuals into asset creating individuals and non-asset creating individuals the improved method comprising the steps of: in the equipment management system, a. flagging a piece of equipment assigned to an asset-creating individual; b. documenting the occurrence of an asset-creating event; and c. designating said piece of equipment an asset." Again, *Conway* fails to disclose the concepts of asset creating individuals and non-asset creating individuals, flagging a piece of equipment assigned to an asset creating individual, documenting the occurrence of an asset creating event, and designating the piece of equipment an asset. Thus, *Bowers I* in view of *Conway* fails to 25 disclose each element of the invention of claim 3. Claims 4 and 5 depend from claim 3, and 30 disclose each element of the invention of claim 3.

are allowable at least for the reasons that they depend from an allowable base claim and add limitations not found in the prior art.

In regards to the protest, the Protestor also admits that *Bowers II* fails to teach recordation of asset creating events that the inventory may be used in. However, *McWilliams* fails to address the deficiencies of *Conway*, and in fact, fails to even disclose the equivalent of "a flag 97 indicating whether the supply has been "costed," i.e., charged to a patient and *assumed to be consumed in supplying services to that patient*," as disclosed in *Conway*. As such, *McWilliams* is deficient in that it even fails to disclose a flag that indicates *any* change in status. This is because *every single piece* of sports memorabilia disclosed in *McWilliams* will be an asset that has been signed by an asset-creating individual. *McWilliams* fails to disclose any difference between asset creating events and non-asset creating events, and asset-creating individuals and non asset-creating individuals, because it is known *a priori* that all events will be asset-creating events, and that all individuals will be asset-creating individuals. In regards to claim 1, there is no need for "turning an individual flag on for an asset-creating individual profile," because all persons autographing the memorabilia are asset-creating individuals; there is no need for recording the return of said equipment after an asset-creating event, because the equipment is not returned but is instead sold to a buyer; there is no need for turning an event flag on for equipment used in said asset-creating event, because all memorabilia is used in an asset-creating event; and there is certainly no need for determining if said equipment is now an asset by checking for a group flag, an individual flag and an event flag, because it is known in advance that the memorabilia is going to belong to a group of actual (as opposed to potential) assets, that the individual signing the memorabilia is going to be an asset-creating individual, and that the event is a going to be a signing.

Likewise, with regards to claim 2, there is no need in *McWilliams* to turn any flag off for equipment assigned to a non-asset-creating individual profile, as there are no non-asset creating individuals disclosed in *McWilliams*; there is need to record the return of said equipment after an asset-creating event, because the memorabilia of *McWilliams* is sold to a buyer after it is signed; and there is no need to determine if the memorabilia is now an asset by checking for an asset flag turned on and use in an asset-creating event, because it is known *a priori* that the memorabilia will be an asset and will be used in an asset-creating event.

With regards to claim 3, *McWilliams* utterly fails to distinguish between asset creating individuals and non-asset creating individuals - it is known in advance that only an asset-creating individual will be signing the memorabilia. Why would anyone use the system of *McWilliams* to have non-asset creating individuals sign sports memorabilia? The entire system
5 of *McWilliams* is used to confirm the authenticity of items where it is known in advance that the item is going to become a piece of memorabilia - the asset-creating event of *McWilliams* is the signature of the item. Unlike the present invention, *McWilliams* would be unable to distinguish whether the item that has been signed was used in a game, who it was used by, which game it was used in, or any other details other than the mere fact that the item was
10 signed by an asset-creating individual. Furthermore, *McWilliams* fails to disclose flagging a piece of equipment assigned to an asset-creating individual, as none of the memorabilia is assigned to the person signing it.

New claims 16 through 20 are presented herewith, and are novel and non-obvious over the prior art for the reasons discussed above and for other reasons that are readily apparent.
15 No new matter has been added Withdrawal of the rejection of claims 1-5 and allowance of all pending claims is respectfully requested.

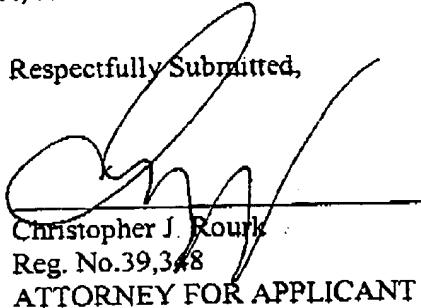
CONCLUSION

In view of the foregoing remarks and for various other reasons readily apparent, Applicants submit that all of the claims now present are allowable, and withdrawal of the rejections and a Notice of Allowance are courteously solicited.

5 If any impediment to the allowance of the claims remains after consideration of this amendment, and such impediment could be alleviated during a telephone interview, the Examiner is invited to telephone the undersigned at (214) 969-4669 so that such issues may be resolved as expeditiously as possible.

An additional fee of \$86.00 for two additional independent claims is believed to be
10 required with this response, as well as a fee of \$55.00 for a one-month extension of time, a petition for which is hereby made. If any applicable fee or refund has been overlooked, the Commissioner is hereby authorized to charge any fee or credit any refund to the deposit account of Akin, Gump, Strauss, Hauer & Feld, L.L.P., No. 01-0657.

Respectfully Submitted,



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